

REMARKS

Claims 1-3 and 6-16 are pending in this application. Claims 1 and 11 are independent. In light of the amendments and remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

The Official Action

In the outstanding Official Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Ryne et al. (USP 6,389,924); and rejected claims 2, 7, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ryne et al. Applicant respectfully traverses these rejections.

Applicant wishes to thank the Examiner for noting claims 3, 6, 8-10, and 13-15 as containing allowable subject matter.

Claim Rejections - 35 U.S.C. § 102

With regard to the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Ryne et al., the Examiner asserts that Ryne et al. discloses the supporting mechanism of the present invention. Applicant respectfully disagrees with the Examiner's characterization of this reference.

It is respectfully submitted that in order to find anticipation of a claimed invention under 35 U.S.C. § 102, the cited reference must teach each and every claim element. In support

of the Examiner's rejection of claim 1, the Examiner asserts Ryne et al. teaches

a supporting mechanism (30, seen best in Figure 2) for supporting the motor on a stationary member and the supporting mechanism has a releasing mechanism, shown as a pin on one side of the supporting mechanism and a hole and slot on the other side of the supporting mechanism, for releasing support of the motor on the stationary member by impact energy applied to the motor. It is understood that any connection, and especially the connection shown in Figure 2 would disconnect under impact.

Applicant respectfully disagrees with the Examiner's assertions.

It is respectfully submitted that the disclosure set forth in Ryne et al. is directed to a steering column for a motor vehicle. Ryne et al. discloses the column mounted electric power assist apparatus 12 includes a structural housing 26 and an electric motor 28 rigidly attached to the housing at a mounting flange 30.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an electric power steering apparatus comprising a supporting mechanism for supporting the motor on a stationary member, wherein the supporting mechanism has a releasing mechanism for releasing support of the motor on a stationary member by impact energy applied to the motor. It is respectfully submitted that nowhere in the Ryne et al. reference is there any teaching or suggestion of impact energy being applied to the motor. While Ryne et al. provides a detailed disclosure relating to the column

mounted electric power assist apparatus, the only disclosure directed to mounting flange 30 (purportedly teaching the support mechanism of the present invention) is merely to note that the mounting flange 30 is utilized to rigidly attach the electric motor to the housing. There is no discussion in *Ryne et al.* that is directed to impact energy applied to the motor.

Further, there is no discussion in *Ryne et al.* that is directed to the supporting member having a releasing mechanism for releasing support of the motor on the stationary member by impact energy applied to the motor. It appears the Examiner is assuming that *Ryne et al.* shows a projection and a recess provided on the mounting flange 30, where the projections are inserted into their respective recesses. The Examiner further assumes motor and flange 30 are fixed by rotating them clockwise. The Examiner concludes by asserting that if impact energy is applied, the fixing is released by rotating the flange and motor counter-clockwise.

It is well settled therefor that a rejection under 35 U.S.C. § 102 is not proper based on the present facts. See, for example, Continental Can Co. USA, Inc. v. Monsanto, 20 USPQ2d, 1746, 1749, 1750 (Fed. Cir. 1991), which stated as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled . . .

[such] that the missing . . . matter is necessarily present in the . . . reference, and that it would be so recognized by persons of ordinary skill. . . "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient . . .

Thus, assuming, *arguendo*, that it is possible that the support of the motor on a stationary member may be released due to impact energy being applied to the motor, this possibility is insufficient to show anticipation under 35 U.S.C. § 102.

As such, it is respectfully submitted that since *Ryne et al.* fails to teach or suggest all of the elements set forth in claim 1, claim 1 is not anticipated by *Ryne et al.*

It is further respectfully submitted that claims 2-3, 6-10, and 12-13 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

Claim Rejections - 35 U.S.C. § 103

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to

combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In considering the Examiner's argument in support of the rejection of claim 11, the Examiner is relying upon the slot arranged with the recess or hole to teach or suggest an arc-shaped groove provided at the shaft housing. Applicant respectfully disagrees with the Examiner's characterization of this reference.

As noted above, *Ryne et al.* discloses a steering column for a motor vehicle. The column mounted electric power assist apparatus includes structural housing 12 and an electric motor 28 rigidly attached to the housing at a mounting flange 30. As can be seen in Fig. 2, mounting flange 30 includes the "recess or hole" as admitted by the Examiner. Thus, it is respectfully submitted that *Ryne et al.* fails to disclose **an arc-shaped groove** provided at the **shaft housing**. Thus, as the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

Further, it is respectfully submitted that the hole or recess at reference 30 taught or suggested by *Ryne et al.* does not teach

or suggest an arc-shaped groove as set forth in claim 11. Finally, *Ryne et al.* fails to teach or suggest a projection being inserted so as to be movable in a length direction of the groove. As such, since *Ryne et al.* fails to teach or suggest all of the elements of claim 11, it is respectfully submitted that claim 11 is not obvious over *Ryne et al.* It is respectfully requested that the outstanding rejection be withdrawn.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 10/002,008

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Cynthia Vorster
Rev. # 87327

for Michael K. Mutter, #29,680

MKM/CMV/jdm
1560-0374P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000